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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,774	08/20/2003	Paul E. Jacobs	000370D1	8775

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
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EXAMINER
ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/645,774	JACOBS ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-35 are presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-35 are rejected under 35 U.S.C. 101 because the claims recite functional descriptive material (software/program per se). For example claim 1, can be rewritten as "a computer-readable medium having stored therein computer-executable instructions for use on a client device.....".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40, 111-113, 126-127, 136-137 and 146 of copending Application No.09/679,039. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad-statistical data. Calculating and transmitting statistical data it is old and well known in business in order to calculate and transmit statistical data in order to make educated assumptions and statements on a particular subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

4. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.09/679,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites an ad link history display window that lists links to the sources of advertisements that the user has previously visited. Listing the sources of advertisements or information that the user has previously visited it is old and well known in order to keep track of the success of the different sources of advertisements. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included a display window that lists links to the sources of advertisements that the user has previously visited in order to achieve the above mentioned advantage.

5. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No.09/728,693. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the copending application further recites that the advertisement download communication link and the data communication link are separate communication links. It is old and well known in the communication and networking arts to have various communication links because such a modification would allow for easier transmission of data. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have link are separate communication links in order to achieve the above mentioned advantage.

6. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No.09/728,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites that the advertisement download communication link and the data communication link are separate communication links. It is old and well known in the communication and networking arts to have various communication links because such a modification would allow for easier transmission of data. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have link are separate communication links in order to achieve the above mentioned advantage.

7. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-33, 59 and 62 of copending Application No.09/668,331. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded.

Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

8. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 46-70 and 74-76 of copending Application No.09/668,632 Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites an e-mail function for receiving and sending e-mail to other client devices. Sending and receiving e-mail to other clients is old and well known in the computer related arts in order to receive messages immediately from other clients . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and sending e-mail messages in order to achieve the above mentioned advantage.

9. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-70, 74-76 and 78 of copending Application No.09/668,515.Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application further recites three operating modes. Different operating modes such as Online and offline operating modes are known in the computer related arts in order to provide different states of the program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and

sending e-mail messages in order to achieve the above mentioned advantage.

10. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,9-11,14-24,43,45-54,77-79,81,82,84,86-92,94,95,97-105,107-109 and 111 of copending Application No.09/668,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

11. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No.09/668,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites a third operating mode in which the software switches the operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode. Official notice is taken that it is old and well known in the computer related arts to switch from one operating mode to another operating mode that has less features when a problem arises with one of the operating mode because such a modification would allow the software to operate with less features and in that case less problems are less likely to occur. It would have been

obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included switching from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode in order to obtain the above mentioned advantage.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (5,848,397 hereinafter Marsh) in view of Werkhoven (WO 99/59097 hereinafter Werkhoven).

With respect to claims 1, 8, 16, 17, 20, 23, 29, Marsh teaches software for use on a client device that is configured for communications with a multiplicity of other client devices via a communication network (Abstract). An e-mail composition function for enabling a user of the client device to compose e-mail messages (col. 6, lines 16-29); an e-mail send function that enables the user to send e-mail messages to other client devices via the communication network (col. 6, lines 16-29); an e-mail receive function that enables the user to receive e-mail messages from other client devices via the communication network (col. 6, lines 16-29); an advertisement download function that

downloads advertisements from at least one remote source, during one or more advertisements download sessions (see figure 4, item 601); an advertisement store function that stores the download advertisements on a storage medium associated with the client device (col. 14, lines 1-10); an advertisement display function that effects display of at least selected ones of the stored advertisements on a display associated with the client device (Figure 6, 702).

With respect to an ad obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement current being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display and an obscured nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured nag display notifies the user of the obscured ad condition. Werkhoven teaches an Internet advertising system, the system monitors if a user opens a window in front of the popup window which has the advertisements, if the system detects that a popup window has been blocked for a predetermined time, then the user is notified of the time limit by returning the pop window to the frontmost position (see page 6, lines 2-5). It would have been obvious to a person of ordinary skill inn the art at the time of Applicant's invention to have included the teachings of Werkhoven of ad obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement current being displayed on the display associated with the client device is being obscured by one or more other items

currently being displayed on the display and an obscured nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured nag display notifies the user of the obscured ad condition because such a modification would allow to "**determine if the user had closed the window containing the advertisement before the advertisement could complete its presentation**" (col. 1, lines 28-30).

With respect to claim 2, Marsh further teaches a data communication link with a data communications service provider, via the communications network, wherein the advertisement download communication link and the data communication link are separate communication links (Figure 4).

With respect to claim 3, Marsh further teaches that the method is installed on the client system and the advertisement distribution server system is controlled by a vendor of the software (col. 3, lines 12-56).

With respect to claim 4, Marsh further teaches that the communication network comprises the Internet (Figure 1 and col. 6, lines 16-29).

Claim 5-7 further recite a first e-mail service provider for storing and forwarding outgoing e-mail messages, and a second e-mail service provider server system for storing and forwarding incoming e-mail messages. Marsh teaches forwarding and

receiving e-mail messages (Figure 8). With respect with the e-mail service providers being different service providers. Official notice is taken that is old and well known for various providers to offer e-mail service to users. For example, a user uses America Online for its Internet services and can receive or send e-mail to a Comcast user and vice versa, users with the same providers can receive or send e-mail to each other. It would have been obvious for a person of ordinary skill in the art at the time of Applicant's invention to have included the e-mail service providers being different service providers because such a modification would allow users to join the system without having to change their providers.

With respect to claims 10, 30, Marsh further teaches that the display of the at least ones of the stored advertisements comprises displaying the at least selected ones of the stored advertisements when the client device is offline (col. 6, lines 63-, col. 7, line 1).

With respect to claim 11, Marsh further teaches that the advertisement display function effects display while the user is composing/reading e-mail messages (col. 7, lines 1-6).

With respect to claims 9, 12, 24-25 Marsh further teaches that the ad display parameters are unknown to the e-mail service provider (i.e. the ad display parameters

are generated from advertiser 108, which is separate from e-mail service provider 107)(see Figure 8).

With respect to claims 13-14, Marsh further teaches that the advertisement download session limited to a prescribed maximum time duration (col. 3, lines 28-37).

With respect to claim 15, Marsh further teaches that the advertisement download communication link is not the same communication link as the e-mail communication link (i.e. In Marsh, the user can access the e-mail without accessing the advertisements. The user makes a first communication link to access the e-mail and then in order to access the advertisements, the user makes a second communication link by clicking on the advertisements, which is a separate link from the first communication link) (col. 7, lines 57-65).

Claims 18 and 19 further recite that the images comprises GIF image, PNG image, and JPEG image. Official notice is taken that it is old and well known in the computer related arts to convert a data file or a message may be encoded into a variety of compression formats. Some of these formats, such as JPEG, GIF, PNG have built-in variable compression. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included comprises GIF image, PNG image, or JPEG image such a modification would be favorable because it allows for a still image to be compressed.

Claim 21 further recites displaying at least ones of the advertisements in a random manner. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included displaying the advertisements in a random manner in order to obtain the above mentioned advantage.

Claim 22 further recites displaying at least ones of the advertisements in a linear manner. Official notice is taken that it is old and well known to display in a linear manner in order to provide an output that is proportional. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included recites displaying at least ones of the stored advertisements in a linear manner in order to achieve the above mentioned advantage.

With respect to claim 26, Marsh further teaches that the ad display parameter are prescribed by a vendor of the software (col. 3, lines 12-56).

With respect to claims 27-28, the limitations were previously addressed in rejected claims 12 and 24-25 above and therefore is rejected under similar rationale.

Claims 31-32 further recite giving the user a choice of removing whatever is obscuring the advertisement and switching the operating from a first operating mode to

a second operating mode, wherein the second operating mode has less features than the first operating mode. The combination of Marsh and Werkhoven teach giving the user a choice of opening a pop window in front of the advertisement displayed and notifying the user that he or she is obscuring the advertisements by removing whatever is obscuring the advertisement (i.e. bringing the advertisement from the background to the foreground)(see rejection above of claims 1-3, 6-8, 11-18 and 51-53). With respect to operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode. Official notice is taken that it is old and well known in the computer related arts to switch from one operating mode to another operating mode that has less features when a problem arises with one of the operating mode because such a modification would allow the software to operate with less features and in that case less problems are less likely to occur. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included as one of the choices switching the operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode in order to obtain the above mentioned advantage.

With respect to claims 33-35, Marsh teaches an installer function for installing the software on a computer-readable storage medium on the client device(col. 3, lines 12-56).

Point of contact

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

For the upcoming move to the new Alexandria office, everyone has been assigned new phone and RightFax numbers. My new phone number will be : 571-272-6715, my supervisor's phone number will be: 571-272-6724.. This changes will not happen until April 2005 (or later) and therefore our current numbers are still in service until the move.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 3622

R.A.

1/25/05